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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/726,648

Applicant(s)

KIM, JONG-TAK

Examiner

UMAR CHEEMA

Art Unit

2444

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8, 12-16, 18, 19 and 26-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 12-16, 18, 19 and 26-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the Amendment filed on 02/04/2010. Claims 1-5, 8, 12-16, 18, 19, and 26-38 are pending in this action. Claims 1, 2, 8, and 26 have been further amended.

Response to Arguments

2. Applicant's arguments filed on 02/04/2010 with respect to claims 1-5, 8, 12-16, 18, 19, and 26-38 have been considered but they are not persuasive.
3. Applicant's argument with respect to these claims, are that none of the cited references single or in combination teach or suggest, "an index value which provides an indication of whether a multimedia message is new multimedia message or a previously send multimedia message." Applicant's argument has been fully considered but Examiner disagrees with Applicant's argument. As cited in details action below and addressed in previous actions that Barrus teaches or suggests an index value which provides an indication of whether a multimedia message is new multimedia message or a previously send multimedia message (see see col. 1, lines 27-36; storing multimedia message; col. 8, lines 11-52; object-indexing unit 306 is also used to generate and store unique indicates etc. also col. 24, lines 35-58 also figures 3, 16 and the details associated; wherein method for creating a new message or replying to an existing one is described). However, Applicant assert to argue that the fist and second index values in Applicant's claimed invention are different than one cited in the Examiner's references. Examiner notes that the claimed "index value" is broadly recited, and is not limited by the claim language regarding any specific mechanics. As noted by Applicant, "Remarks", page 10, lines 19-20, the value may include or be based on, for example, a telephone number or address etc..

Examiner submits that any of the index value (object-indexing, key action-to-index as used by Barrus, or any other indexing used in Shaw and Takahashi) are clearly reading on the index values as claimed in Applicant's invention. Applicant asserts to further argue that since "index values" of applicant's claimed invention are different than the one cited by the Examiner, cited claims can not teach other aspects of these claims. Examiner disagrees with applicant's arguments since index values of claimed invention are taught or suggested in cited references. "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). See MPEP 2144.01. Therefore it is Examiner's position that such limitations are taught or suggested by cited references and 35 U.S.C 103(a) rejection to claims 1-19 and 26-37 is proper.

4. The breath of the claims allows for such an interpretation. Applicant employs broad language which includes the use of words and phrases which have broad meaning in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breath allows multiple interpretations and meaning which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly as reasonably possible, in determining patentability of the disclosed invention. Again, claims are interpreted in light of the specification; limitations from the specification are not read into the claims. See *In re Van Geuns*, 998 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 has been amended to include limitations, "first index value identifying the multimedia message without identifying any attachments to the multimedia message," which has not been supported in the specification. Since claim 1 is rejected under 35 U.S.C 112, first paragraph, all of its dependent claims are rejected for at least their dependency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-5, 8, 12-16, 18, 19, and 26-32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrus et al. (hereinafter Barrus) (US Patent No. 6,784,899) in view of Takahashi et al. (hereinafter Takahashi) (US Patent No. 5,819,261) and further in view of Shaw et al. (hereinafter Shaw) (US Patent No. 6,816,887).

7. Regarding claim 1, Barrus discloses the invention as claimed a method comprising: receiving a multimedia message from a user agent [see abstract, col. 1, lines 27-36; storing, generating, retrieving, receiving and sending multimedia messages including an audio communication device, a visual output device, a remote access system and a multimedia message system]; setting a first index value of the multimedia message, wherein the first index value is set as a value to identify and discriminate the multimedia messages the first index identifying the media message without identifying any attachments to the multimedia message; storing the multimedia message having the set first index value in a storage device [see col. 1, lines 27-36; storing multimedia message; col. 8, lines 11-52; object-indexing unit 306 is also used to generate and store unique indicates etc.]; receiving information including a second index value from the user agent, wherein the second index indicates whether the multimedia message to be forward is a new multimedia message or a previously sent multimedia message [see col. 24, lines 35-58 also figure 3, 16 and details associated; wherein method for creating a new message or replying to an existing message is described].

8. Barrus substantially discloses the invention as claimed above but Barrus does not explicitly disclose wherein said searching whether the multimedia message to be forwarded exists in the storage device based on a comparison of the second index value in the information received from the user agent and the first index value set in the stored multimedia message.

9. In the same field of invention, Takahashi disclose wherein said searching whether the multimedia message to be forwarded exists in the storage device based on a comparison of the second index value in the information received from the user agent and the first index value set in the stored multimedia message [see **Takahashi: abstract, col. figure 9-11, 14 a-c and details associated; col. 18, lines 56-64; wherein predetermined counter is set to searching and transmitting message is described**].

10. It would have been obvious to one of the ordinary skills person in the art of networking at the time of the invention to combine the teaching of Barrus and Takahashi for a method comprising setting an index value of a multimedia message. Motivation for doing so would have been advanced and easy search for existing messages.

11. Barrus-Takahashi substantially disclose the invention as described above but do not explicitly disclose wherein forwarding the multimedia message produced by the search, wherein, if a storing time of the multimedia message in the storage device elapses, the second index value is set as a value indicating a new multimedia message even though the multimedia message to be forwarded is a previously sent multimedia message.

12. In the same field of invention, Shaw discloses wherein forwarding the multimedia message produced by the search, wherein, if a storing time of the multimedia message in the storage device elapses, the second index value is set as a value indicating a new multimedia message even though the multimedia message to be forwarded is a previously sent multimedia message [see **figures 9, 10 and details associated; wherein identifying and displaying object/messages based on set value are being transmitting in buffer to message processing unit etc.**].

13. It would have been obvious to one of the ordinary skills person in the art of networking at the time of the invention to combine the teaching of Barrus-Takahashi into Shaw for a method comprising setting an index value of a multimedia message and forwarding the message based on set index value. Motivation for doing so would have been to improved method and apparatus for sending private messages [see Shaw: col. 2, lines 9-12].

14. Regarding claim 2, Barrus discloses the method of claim 1, wherein the first index value is set in a header of the multimedia message [see col. 13, lines 46-63, figure 7 and the details related].

15. Regarding claim 4, Barrus discloses the method of claim 2, wherein the second index value is set as a value corresponding to '0' when the multimedia message to be forwarded is a new multimedia message or changed [see figures 9A-B and the details related, col. 16, lines 22-51; predetermined input bit or character etc. and col. 24, lines 35-58 also figure 3, 16 and details associated; wherein method for creating a new message or replying to an existing message is described].

16. Regarding claim 5, Barrus discloses the method of claim 2, wherein the second index value is set as a value corresponding to other than '0' when the multimedia message to be forwarded is a previously sent multimedia message [see figures 9A-B and the details related, col. 16, lines 22-51; predetermined input bit or character etc. and col. 24, lines 35-58 also figure 3, 16 and details associated; wherein method for creating a new message or replying to an existing message is described].

17. Regarding claims 6-7, (Canceled).

18. Regarding claim 8, Barrus discloses a method comprising: transmitting header information of a multimedia message from a user agent to a server; and determining an index value of the transmitted header information, wherein the index value indicates whether the multimedia is a new multimedia message or a previously sent multimedia message, the index value having a first value when the multimedia message is a new multimedia message and a second value when the multimedia message is a previously sent multimedia message [see col. 24, lines 35-46, 52-58 also figures 3, 16 and the details related; indexing unit]; retrieving a multimedia message having a same index value in a mailbox if the multimedia message is a previously sent multimedia message [see col. 13, lines 46-63, figure 7, col. 24, lines 35-58 also figure 3, 16 and details associated; wherein method for creating a new message or replying to an existing message is described]; inserting information of a receiving side in the retrieved multimedia message [see col. 1, lines 27-36; storing, generating, retrieving, and sending multimedia messages etc.].
19. Barrus discloses substantially the invention as claimed above but Barrus does not explicitly disclose wherein said transmitting header information of a multimedia message from a user agent to a server; and determining an index value of the transmitted header information.
20. In the same field of invention Takahashi discloses wherein said transmitting header information of a multimedia message from a user agent to a server; and determining an index value of the transmitted header information (see figures 1, 8 and the details related, col. 9, lines 7-42; transmitting header information).
21. It would have been obvious to one of the ordinary skill person in the art of networking to combine the teaching of Barrus and Takahashi for a method comprising setting an index value of

a multimedia message and forward the message based on the set index value. Motivation for doing so would have been because it this functionality extends the usefulness of the multimedia message system's capabilities (see Barrus: col. 2, lines 49-52).

22. Barrus-Takahashi substantially disclose the invention as described above but do not explicitly disclose wherein transmitting the multimedia message to a user agent on the receiving side, wherein if a storing time of the multimedia message in the mailbox elapses, the index value is set as a value indicating a new multimedia message even though the multimedia message to be forwarded is a previously sent multimedia message.

23. In the same field of invention, Shaw discloses wherein transmitting the multimedia message to a user agent on the receiving side, wherein if a storing time of the multimedia message in the mailbox elapses, the index value is set as a value indicating a new multimedia message even though the multimedia message to be forwarded is a previously sent multimedia message **[see figures 9, 10 and details associated; wherein identifying and displaying object/messages based on set value are being transmitting in buffer to message processing unit etc.]**.

24. It would have been obvious to one of the ordinary skills person in the art of networking at the time of the invention to combine the teaching of Barrus-Takahashi into Shaw for a method comprising setting an index value of a multimedia message and forwarding the message based on set index value. Motivation for doing so would have been to improved method and apparatus for sending private messages [see Shaw: col. 2, lines 9-12].

25. Regarding claim 9-11, (Canceled).

26. Regarding claim 13, Barrus discloses the method of claim 8, wherein the index value in the mailbox includes a predetermined bit to discriminate among multimedia message [see figures 9A-B and details associated, col. 16, lines 22-51; predetermined input bit or characters etc.].
27. Regarding claim 14-15, these claimed limitations are substantially same as previously rejected claims 4-5, therefore, are rejected for the same reasoning [see claims 4-5 details above].
28. Regarding claim 16, Barrus discloses the method of claim 14, wherein the index value is set as a value corresponding to other than '0' when the multimedia message is a previously sent multimedia message [see figures 9A-B and the details related, col. 16, lines 22-51; predetermined input bit or character etc.].
29. Regarding claim 17, (Canceled).
30. Regarding claim 18, Barrus discloses the method of claim 8, where wherein the multimedia message stored in a mailbox has a predetermined storage time set by a multimedia user agent [see figures 9A-B and the details related, col. 16, lines 22-51; predetermined input bit or character etc.].
31. Regarding claim 19, Barrus discloses the method of claim 18, further comprising automatically deleting the multimedia message stored in the mailbox when the set storing time elapses [see fig. 6 and the details related, create, edit, delete and retrieve multimedia messages, col. 13, lines 28-36].
32. Regarding claim 20-25, (Canceled).
33. Regarding claim 26, Barrus discloses the invention as claimed a server comprising: a receiving device to receive at least an index value of a multimedia message [see abstract, col. 1, lines 27-36; storing, generating and retrieving, receiving and sending multimedia

messages]; a processor to select information to transmit based on the index value [**see col. 7, lines 45-59, figure 3 as well as figures 1-2 and the related details**], wherein the index value indicates whether the multimedia is a new multimedia message or a previously sent multimedia message, the index value having a first value when the multimedia message is a new multimedia message and a second value when the multimedia message is a previously sent multimedia message [**see col. 24, lines 35-46, 52-58 also figures 3, 16 and the details related; indexing unit**].

34. Barrus discloses substantially the invention as claimed above but Barrus does not explicitly disclose wherein said transmitting device to transmit at least the selected information.

35. In the same field of invention Takahashi discloses wherein said transmitting device to transmit at least the selected information [**see figures 1, 8 and the details related, col. 9, lines 7-42; transmitting header information**].

36. It would have been obvious to one of the ordinary skill person in the art of networking at the time of this invention to combine the teaching of Barrus and Takahashi for a method comprising setting an index value of a multimedia message and forward the message based on the set index value. Motivation for doing so would have been because it this functionality extends the usefulness of the multimedia message system's capabilities [**see Barrus: col. 2, lines 49-52**].

37. Barrus-Takahashi substantially disclose the invention as described above but do not explicitly disclose wherein transmit at least the selected information, wherein, if a storing time of the multimedia message stored in the server clapses, the user agent sets the index value as a

value indicating a new multimedia message even through the multimedia message is a previously sent multimedia message.

38. In the same field of invention, Shaw discloses wherein transmit at least the selected information, wherein, if a storing time of the multimedia message stored in the server elapses, the user agent sets the index value as a value indicating a new multimedia message even through the multimedia message is a previously sent multimedia message **[see figures 9, 10 and details associated; wherein identifying and displaying object/messages based on set value are being transmitting in buffer to message processing unit etc.]**.

39. It would have been obvious to one of the ordinary skills person in the art of networking at the time of the invention to combine the teaching of Barrus-Takahashi into Shaw for a method comprising setting an index value of a multimedia message and forwarding the message based on set index value. Motivation for doing so would have been to improved method and apparatus for sending private messages [see Shaw: col. 2, lines 9-12].

40. Regarding claim 27-31, the claimed limitations are substantially same as previously addressed claims 2-3, 5-7 [see claims 2-3, 5-7 rejection above].

41. Regarding claim 32, Barrus discloses the server of claim 26, wherein the processor decides to retrieve a multimedia message having a similar index value from a memory based on the determined index value [see col. 1, lines 27-36; storing, generating and retrieving, receiving and sending multimedia messages including an audio communication device, a visual output device, a remote access system and a multimedia message system].

42. Claims 3 and 12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrus-Takahashi- Shaw and further in view of Kuthyar et al. (Kuthyar) (US Patent # 5,768,513).

43. Regarding claims 3 and 12, Barrus-Takahashi-Shaw disclose the limitations of claims 2 and 8, but do not explicitly disclose wherein the information of the receiving side comprises one of a telephone number and an address of the receiving side.

44. In the same field of invention, Kuthyar discloses wherein the information of the receiving side comprises one of a telephone number and an address of the receiving side [see fig. 2, col. 4, lines 7-23].

45. It would have been obvious to one of the ordinary skill in the art of networking at the time of the invention to combine the teaching of Barrus-Takahashi-Shaw and Kuthyar for receiving information where information contains telephone number and an address of the receiving side. Motivation for doing so would have been that it provides an improved multimedia messaging service capabilities [see Kuthyar: pg. 1, lines 58-60].

46. Claims 33-38, are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrus et al. (hereinafter Barrus) (US Patent No. 6,784,899) in view of Takahashi et al. (hereinafter Takahashi) (US Patent No. 5,819,261).

47. Regarding claim 33, Barrus discloses the invention as claimed a method for processing a multimedia message comprising: transmitting one of (a) a multimedia message including the index value in the header of the multimedia message, wherein the index value indicates that the multimedia message is a new multimedia message or a changed multimedia message from a previously sent multimedia message [see col. 24, lines 35-46, 52-58 also figures 3, 16 and the details related; indexing unit] or (b) only a header of a multimedia message, wherein an index value of the header indicates the multimedia message was a previously sent multimedia message, which has not changed [see col. 24, lines 35-46, 52-58 also figures 3, 16 and the details

related; indexing unit]; and receiving one of the header in (b) or the multimedia message in (a), wherein when only the header in (b) is received, the method further comprises retrieving the multimedia message having a corresponding index value as the received header from a storage device [see col. 4, lines 1-10; figures 3, 12-13 and the details related; storing, generating and receiving, receiving and sending multimedia messages].

48. Barrus discloses substantially the invention as claimed above but Barrus does not explicitly disclose wherein said transmitting message.

49. In the same field of invention Takahashi discloses wherein said transmitting message [see figures 1, 8 and the details related, col. 9, lines 7-42; transmitting header information].

50. It would have been obvious to one of the ordinary skills person in the art of networking at the time of this invention to combine the teaching of Barrus and Takahashi for a method comprising setting an index value of a multimedia message and forward the message based on the set index value. Motivation for doing so would have been because it this functionality extends the usefulness of the multimedia message system's capabilities [see Barrus: col. 2, lines 49-52].

51. Regarding claim 34, the limitations of this claim has already been addressed (see claim 5 above).

52. Regarding claim 35, the limitations of this claim has already been addressed (see claim 4-5 above).

53. Regarding claim 36, the limitations of this claim has already been addressed (see claim 13 above).

54. Regarding claim 37, the limitations of this claim has already been addressed (see claim 31 above).

55. Regarding Claim 38, the combination of Barrus-Takashi discloses the method of claim 1, wherein said receiving includes: receiving header information that includes the index value, the header information received without multimedia information when the index value indicates that the multimedia message is not a changed message or first-sent message [see Barrus: col. 24, lines 35-46, 52-58 also figures 3, 16 and the details related; indexing unit; Takashi: figures 1, 8 and the details related, col. 9, lines 7-42; transmitting header information]. It would have been obvious to combine teaching of Barrus-Takashi for the same motivation as previously presented in claim 33.

Conclusion

56. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

57. Any inquiry concerning this communication or earlier communications from the examiner should be directed to UMAR CHEEMA whose telephone number is (571)270-3037. The examiner can normally be reached on M-F 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Jr. Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/U. C./
Examiner, Art Unit 2444
/William C. Vaughn, Jr./
Supervisory Patent Examiner, Art Unit 2444